

REMARKS

Reconsideration of the objection and the rejections set forth in the Office Action dated April 11, 2006, is respectfully requested. The Examiner rejected claims 83-110. Applicants have amended claims 83, 93, and 96 and have added new claims 111-114. Accordingly, claims 83-114 remain pending in the application. No new matter has been added by these amendments as can be confirmed by the Examiner.

A. The Pending Claims Are Fully Supported by the Original Specification.

In the Office Action, the Examiner rejected claims 93, 95 and 99-102 under 35 U.S.C. § 112, ¶ 1 as allegedly containing subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

According to the Examiner,

Applicant ... has not pointed to areas of the specification that show "said key generation system generates a **second** unique data identifier for the source file." Applicant has not shown support for a key generation system that generates two unique data identifiers for a single source file. Therefore all of other claim limitations that involve the second unique data identifier lack support. (emphasis original)

The Examiner, for example, asserts that the allegedly added material includes the data management system, wherein "said key generation system generates a second unique data identifier for the source file, wherein said source print generation system extracts a second predetermined number of second source elements from the source file in accordance with said second unique data identifier, and [wherein] said database system associates said second unique data identifier and the second source elements with the source file" as set forth in claim 93.

Other allegedly added material include the recitation of claim 95, wherein "said source print detection system compares the second source elements with corresponding target elements in the target file in accordance with said second unique data identifier and determines whether coincidence exists between the second course elements in the source file and the

target elements in the target file." Claims 99-102 include similar recitations in method form, including a requirement that "said preselected coincidence level differs from said preselected coincidence level" as recited in claim 102.

In contrast to the Examiner's assertions, this claimed subject matter clearly is fully supported in the specification as originally filed and is set forth in such a way as to reasonably convey to one skilled in the relevant art that Applicants had possession of the claimed invention at the time that the application was filed. In the manner discussed in the August 12, 2005, amendment, "[the] key generator 22 resides on the data management server 20 and accepts input from a system manager for defining and generating a data identifier or key." (See specification, e.g., at page 8, lines 22-23.)

More particularly, the original specification discloses a key generation system that can generate multiple unique data identifiers for a single source file. The original specification, for example, provides:

Once the data is received from an owner, a unique identifier, or source print, is created for the data. Prior to creating the source print for each source file, a key, or a set of keys, are defined by the system manager, wherein the key is a template from which corresponding portions in the source file will be recorded. As described above, the key comprises a set of elements that are defined by a plurality of parameters, wherein for each key, the set of elements and the parameters defining the elements differ. In this manner, an unlimited number of unique identifiers, or keys, can be defined for use. Indeed, different keys can be defined for different sets of data files.

See, e.g., id. at page 16, lines 20-26.

The specification also discloses that "[i]t is to be understood that **keys can be added and removed at any time**, thus, the set of usable keys is not stagnant." See, e.g., id. at page 10, lines 14-18 (emphasis added). Therefore, the original specification fully supports not only the claim recitation that "said key generation system generates a **second** unique data identifier for the source file," but also a key generation system that generates any number of unique data identifiers for each source file without limitation.

Furthermore, the second unique data identifier, once generated, is recited in claims 93, 95, and 99-102 as being applied to the source file in substantially the same manner by which the first unique data identifier is claimed to be applied to the source file in independent claims 83 and 96. Claim 93, for example, sets forth that "said source print generation system extracts a second predetermined number of second source elements from the source file in accordance with said second unique data identifier;" whereas, claim 83 recites "a source print generation system that extracts the first source elements from the source file in accordance with said first unique data identifier." Claim 93 also provides "said database system associates said second unique data identifier and the second source elements with the source file," and claim 83 recites "a database system that stores the source file with the embedded information block, said first unique data identifier, the first source elements, and ownership information of the source file."

New claims 111-114 likewise find support in the specification. For example, the original specification teaches:

The source print generator 24 is a program that extracts the key elements defined in the key. In preferred embodiments at least two methods of extracting key elements is utilized by the system; namely, a compression specific method and a non-compression specific method. Data for extracting the key elements for either the compression specific method or the non-compression specific method are contained within the data file and the applied method is determined by the system. In general, the compression specific method allows for faster preparation of the keys as it is a copying of the data information that exists within the files. In one preferred embodiment, both methods are applied to incoming data so that fingerprints for both types of information are stored.

The compression specific method is typically applied to data in a compressed format. In accordance with the compression specific method, the bit sequences corresponding to the key elements are extracted from the source file utilizing the rules, sizes and positions specified in the key. The source print generator 24 builds a concatenated string of all of the elements, wherein the resulting string of data bits is the 'file fingerprint'. A unique file identifier is assigned to the source data and associated with the fingerprint such that the file fingerprint can be identified with the original source file. The file fingerprint is then saved in the database 21. This method can be applied to any type of file, including, but not limited to, video, text and video files, wherein for video files only the index frame, that is, the full frame is reviewed in creating the fingerprint.

To apply the non-compression specific method the compressed data file is expanded into the system's memory. As is commonly

understood, each pixel comprises three colors, namely, red, green and blue. Once expanded, the values for each of the colors in each pixel can be accessed. In accordance with the non-compression specific method, an average value for each color, red, green and blue is calculated for each element. In this manner, a set of three numbers (RGB) is stored for each element. The sets of numbers for each element creates the 'file fingerprint'.

This method can be applied to any type of file, including, but not limited to, audio, text and video files, wherein for video files only the index frame, that is, the full frame is reviewed in creating the fingerprint.

See, e.g., id. at page 10, line 22 – page 11, line 18.

Accordingly, for at least the reasons set forth above, Applicants submit that all pending claims are fully supported by the original specification and respectfully request that the Examiner withdraw the claim rejections of claims 93, 95, and 99-102 under 35 U.S.C. § 112, ¶ 1.

- B. Rabin et al. Does Not Disclose or Suggest Generating a First Unique Data Identifier for a Source File that is Associated with at least one Element Extraction Rule and Extracting First Source Elements from the Source File in Accordance with the Element Extraction Rule as Recited in Amended Claims 83-114.

In the Office Action, the Examiner also rejected claims 83-110 as being allegedly anticipated under 35 U.S.C. § 102(e), or rendered obviously under 35 U.S.C. § 103(a), by Rabin et al., United States Patent No. 6,697,948. Applicants respectfully submit, however that, by failing to disclose each and every element of independent claims 83 and 96, Rabin et al. neither anticipates nor renders obvious claims 83 and 96, as amended. Therefore, it is submitted that claims 83 and 96, as well as claims 84-95 and 97-114 that depend thereon, are in condition for allowance.

Rabin et al. disclose a vendor tag system for software products, wherein the vendor tag system interacts with a monitoring program on a user device to inhibit unauthorized use. According to the Examiner, Rabin et al. at col. 20, lines 63-64 teach that "fingerprints are generated from selected portions of the software ..., which meets the limitation of a key generation system that generates a first unique data identifier for the source file by identifying a predetermined number of source elements in the source file as first source elements [as well as the limitation of] a source print generation system that extracts the first source elements from the source file in accordance with said first unique data identifier."

Without acquiescing, Applicants have amended independent claims 83 and 96 to recite that the first unique data identifier is associated with at least one element extraction rule and that the first source elements are extracted from the source file in accordance with the element extraction rule. These claim amendments are fully supported by the original specification. The original specification, for example, discloses:

With reference to Figure 3, the key 30, or file identifier, is a template that comprises a set or a plurality of elements 32, wherein the set of elements defines the key. The key elements 32 are defined by a plurality of parameters or qualifiers, wherein the qualifiers define the characteristics of the key. In preferred embodiments, the qualifiers include, but are not limited to, quantity, element size, start position and initial position of the element. In some preferred embodiments, a set of rules are also defined and associated with the key 30, whereby the data manager can include special rules for particular files or data.

See, e.g., Specification at Fig. 3; page 8, line 28 – page 9, line 4.

The Examiner does not assert that the Rabin et al. teaches associating a first unique data identifier is associated with at least one element extraction rule or extracting the first source elements from the source file in accordance with the element extraction rule. Further, although Rabin et al. mention the use of rules or policies with the disclosed vendor tag system, these rules are associated with the software content and are applied only when access to the software content is sought. See Rabin et al. at col. 47, line 46 – col. 48, line 8; col. 50, lines 22-32. Claims 83 and 96, in contrast, recite that the first unique data identifier is associated with at least one element extraction rule and that the first source elements are extracted from the source file in accordance with the element extraction rule.

At least one recited element of claims 83 and 96 therefore is totally missing from Rabin et al. In accordance with M.P.E.P. § 2131, “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). The disclosure of a claim element in a prior art reference, when relied upon to negate patentability, must also be clear and unambiguous.

Further, "[t]he identical invention must be shown in as complete detail as contained in the...claim." *Richardson v. Suzuki Motor Corp.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Furthermore, and uniquely important in this case is the requirement that the elements relied on in the prior art reference must be arranged as required by the claim. See *In re Bonds*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990).

Accordingly, Applicants submit that Rabin et al. fails to disclose each and every element of claims 83 and 96. Claims 83-114 therefore are not anticipated and are in condition for allowance.

C. No Motivation Exists to Modify the Teachings of Rabin et al. in a Manner that Precludes the Patentability of Claims 83-114 Under 35 U.S.C. § 103(a).

In addition to the reasons stated above, there is no teaching or motivation in the prior art to modify the Rabin et al. reference in a manner that renders claims 83-114 obvious under 35 U.S.C. § 103(a).

In accordance with M.P.E.P. § 2142, the Examiner bears the initial burden of establishing a *prima facie* case of obviousness. "To establish a *prima facie* case of obviousness, three basic criteria must be met." (M.P.E.P. § 2143.) First, some suggestion or motivation in the prior art references or in the knowledge of one of ordinary skill in the relevant art must exist to modify or combine the references. Second, if the references are combined, a reasonable expectation of success must be shown. Then, finally, all of the claim limitations must be taught or suggested by one reference or a combination of references. To establish a *prima facie* case of obviousness based on a single reference that does not teach all the elements of a claim, the Examiner must provide a rationale for modifying the teachings of the reference. See *In re Kotzab*, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000), citing, *B.F. Goodrich Co. v. Aircraft Breaking Sys. Corp.*, 72 F.3d 1577, 1582, 37 U.S.P.Q.2d 1314, 1318 (Fed. Cir. 1996).

In the manner discussed in more detail above, at least one recited element of claims 83-114 is totally missing from Rabin et al. Further, the Examiner does not assert that any teaching or motivation exists in the prior art to modify Rabin et al. in a manner that renders claims 83-114

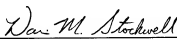
obvious. The Examiner therefore has not established a *prima facie* case under 35 U.S.C. § 103 because, as shown above, all of the elements of the pending claims are not found in the cited reference. According, Applicants respectfully submit that claims 83-114 are not rendered obvious by Rabin et al. and are in condition for allowance.

For at least the reasons set forth above, it is submitted that claims 83-114 are in condition for allowance. A Notice of Allowance is earnestly solicited. The Examiner is encouraged to contact the undersigned at (949) 567-6700 if there is any way to expedite the prosecution of the present application.

Respectfully submitted,

Orrick, Herrington & Sutcliffe LLP

Dated: October 9, 2006

By:   
Davin M. Stockwell  
Reg. No. 41,334  
Attorneys for Applicants

Orrick, Herrington & Sutcliffe LLP  
4 Park Plaza, Suite 1600  
Irvine, California 92614-2558  
Telephone: (949) 567-6700  
Facsimile: (949) 567-6710